REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action dated June 16, 2005. This Amendment is submitted within two months of the mailing date of the Final Office Action. The current status of the claims is summarized below.

5   Claims 1-20 are pending in the application after entry of the present Amendment.

Rejections under 35 U.S.C. § 112

Claims 8-20 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. These rejections are traversed.

10   The Office has asserted that the term "computer readable media" was not sufficiently described in the specification as originally filed. The present application is cross-referenced to U.S. Provisional Application No. 60/291,670. The present application also incorporates by reference the entire specification of U.S. Provisional Application No. 60/291,670. The second full paragraph on page 2 of U.S. Provisional Application No.

15   60/291,670 has been incorporated within the present application immediately before the paragraph beginning at page 25, line 16. The incorporated paragraph states that "The invention can also be embodied as computer readable code on a computer readable medium."

In view of the foregoing, the Applicants submit that the term "computer readable

20   media" as used in claims 8-20 is supported by the specification as originally filed. Therefore, the Office is requested to withdraw the rejections of claims 8-20 under 35 U.S.C. 112.

Rejections under 35 U.S.C. § 101

Claims 1-20 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. These rejections are traversed.

The Office has asserted that the method of claim 1 can be performed by a person

5 as a mental step or using pencil and paper. The Applicants disagree with this assertion by the Office. The method of claim 1 recites "A method for <u>automated acquisition</u> of assertions in a specification of a computer program." The term "automated acquisition" as used in claim 1 indicates that the method is not performed manually, i.e., by a person. The Office has further asserted that it cannot be determined from the claim language that any

10 step of the method of claim 1 requires the presence of hardware/machine. Again, the Applicants disagree with this assertion by the Office. The term "automated acquisition" excludes "manual acquisition." For "automated acquisition" to occur, the method operations are by definition automated. Because the method operations are automated, it can be determined from the claim language that the method operations are to be

15 performed automatically by a capable non-human device.

The Office has further asserted that the language of claim 1 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result. The Applicants also disagree with this assertion by

20 the Office. Claim 1 recites that the sentences marked as testable are used to determine the adequacy of a test suite for testing the computer program. Therefore, claim 1 defines a method having a practical application that produces a concrete, useful, and tangible result. Additionally, according to MPEP 2106, IV, B, 1(a), reciting a computer program as being part of a claim directed to statutory subject matter is not sufficient to render the claim

25 nonstatutory.

In view of the foregoing, the Applicants submit that claim 1 and dependent claims 2-7 recite methods that should be considered statutory subject matter. With regard to claims 8-20, the Office is requested to note the previous arguments responding to the rejections of claims 8-20 under 35 U.S.C. 112. Therefore, the Office is requested to

5   withdraw the rejections of claims 1-20 under 35 U.S.C. 101.

Rejections under 35 U.S.C. § 103

Claims 1-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pavela (U.S. Patent No. 6,332,211) in view of Microsoft Press Computer Dictionary

10   (MPCD). These rejections are respectfully traversed.

The Office has re-applied essentially the same bases of rejection as previously applied in the Office Action dated December 14, 2004. Therefore, the Applicants arguments presented in the Amendment filed March 14, 2005, are incorporated herein by reference. The supplemental arguments provided below are intended to clarify the

15   Applicant's position and rebut the Office's position with respect to finding the Applicant's arguments non-persuasive.

With regard to claim 1, an operation is recited for "receiving the specification as an input, wherein the specification includes a plurality of sentences describing the computer program." Those skilled in the art will appreciate that a specification of a

20   computer program is a conversant textual description of the computer program's functionality. Furthermore, when considering claim 1 in view of the specification, particularly Table 1 and its associated description, it is quite clear that the specification of the computer program refers to a textual description of the computer program's functionality. Furthermore, claim 1 recites that the specification includes a plurality of

25   sentences, i.e., conversant text, describing the computer program.

The Office has attempted to draw an equivalence between the specification of the computer program as recited in claim 1 and source file (318) as taught by Pavela. The Office has asserted that Pavela discloses the source file (318) as being equal to a specification of a computer program at column 2, lines 12-17. Pavela (column 2, lines 12-

5   17) states the following:

"The method comprises the steps of defining a source file having a plurality of tags associated with a member of a library of executable code objects defining a set of instructions for performing a portion of the automatic test procedure, generating a test plan in a conventional language from the source file, and

10   generating an automated test code for the automated test procedure from the source file."

The above-referenced portion of Pavela does not disclose the source file (318) as being equal to a specification of a computer program. Examination of Pavela's teachings beyond the "Summary of Invention Section" discloses that the source file is in fact a <u>user-</u>

15   <u>generated input file</u> that specifies (via a tag nomenclature) a number of information items associated with generation of a test plan and generation of automated test code that complies with the generated test plan. More specifically, column 5 of Pavela describes how the source file is generated manually by a user to include information such as test case objectives, scenario, procedure, system configuration, and the parts used by the test

20   case. Figure 4 of Pavela actually shows an example template of the source file. Furthermore, Pavela (column 5, lines 8-9 and 14-15) teaches that the source file is used as an input file to generate a test plan and automated test code associated with the test plan. Therefore, in contrast to the present invention, the source file description as provided by Pavela does not indicate that the source file represents a specification of a computer

25   program, wherein the specification includes a plurality of sentences describing the

computer program. Rather, the source file of Pavela stores input for generating a test plan and associated test code.

Further with regard to claim 1, an operation is recited for "determining whether the obtained sentence is a testable assertion, wherein the testable assertion describes

5   behavior of an application programming interface that can be tested." The Office has asserted that Pavela (column 2, lines 12-17, and column 6, lines 28-30) teaches the above-reference operation of claim 1. However, the referenced teachings of Pavela merely indicate that the tags in the source file of Pavela can be associated with members of a library of executable test code objects.

10   It should be understood that the tags in the source file of Pavela cannot possibly represent a sentence describing a computer program. Therefore, it is not reasonable to consider the tags of Pavela as representing a testable assertion, wherein the testable assertion describes the behavior of an application programming interface that can be tested. Furthermore, the referenced teachings of Pavela provide no mention of performing

15   a determination as to whether a sentence obtained from the source file represents a testable assertion. The Office has cited a definition of application programming interface as provided in the MPCD reference. However, simply citing a definition of application programming interface does not infer an meaning to the term testable assertion, which is itself absent from the teachings of Pavela.
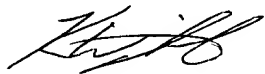
20   Furthermore, the Office has asserted that generation of the test index as taught by Pavela is equivalent to the feature of claim 1 for "marking the obtained sentence as testable when the obtained sentence is a testable assertion." Because Pavela does not teach obtaining sentences from the specification of a computer program and determining whether the obtained sentences represent a testable assertion, it is not reasonable to

25   conclude that Pavela teaches marking the obtained sentences as testable when the

obtained sentence represents a testable assertion. The test index generated in Pavela simply represents a listing of system elements that are tested by a test case, wherein the test case is defined manually via the source file.

Based at least on the above arguments, the Applicants submit that the combination

5   of Pavela and MPCD fails to teach each and every feature of claim 1, as required to render claim 1 prima facie obvious. Furthermore, the Applicants submit that the above arguments provided for claim 1 are equally applicable to similar features recited in each of claims 8 and 14. Therefore, based at least on the above arguments, the Applicants submit that the combination of Pavela and MPCD fails to teach each and every feature of

10   claims 8 and 14, as required to render claims 8 and 14 prima facie obvious. Additionally, the Applicants submit that each of dependent claims 2-7, 9-13, and 15-20 is patentable for at least the same reasons provided for its respective independent claim.

In view of the foregoing, the Applicants request that the Office withdraw the rejections of claims 1-20. The Applicants submit that all of the pending claims are in condition for allowance. Therefore, a Notice of Allowance is requested. If the Examiner has any questions concerning the present Amendment, the Examiner is requested to

5   contact the undersigned at (408) 774-6914. If any additional fees are due in connection with filing this Amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP016). A duplicate copy of the transmittal is enclosed for this purpose.

10   Respectfully submitted,
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